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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,461	07/30/2003	Lynda Fengler	200301157-1	9160
22879	7590	01/18/2007	EXAMINER	
HEWLETT PACKARD COMPANY			INGBERG, TODD D	
P O BOX 272400, 3404 E. HARMONY ROAD			ART UNIT	PAPER NUMBER
INTELLECTUAL PROPERTY ADMINISTRATION				
FORT COLLINS, CO 80527-2400			2193	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/18/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/630,461	FENGLER ET AL.
	Examiner Todd Ingberg	Art Unit 2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 23 October 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 7/30/2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

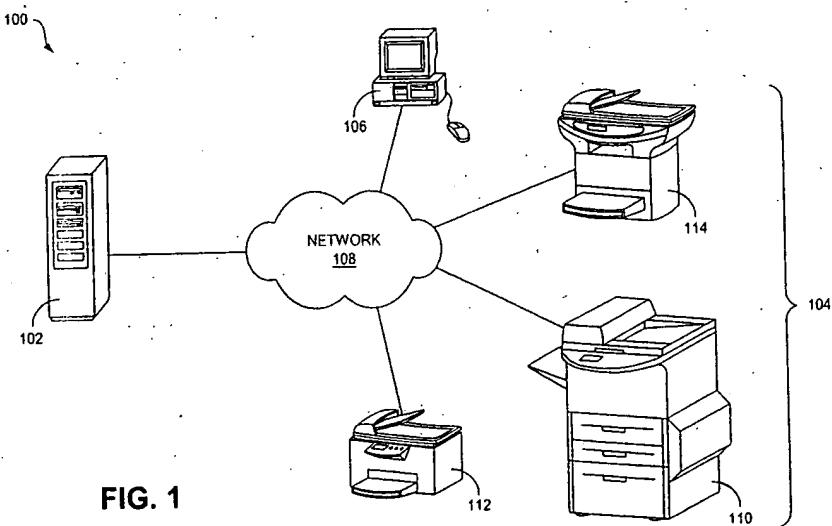
Claims 1 – 34 have been examined.

Claims 1 – 3, 5-9 and 11-34 have been amended.

***Drawings***

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant's argument has been considered and is not persuasive. The following is why Figure 1 is Prior Art as presented to the Office.



Applicant's Figure 1

The Applicant's description in the Specification fails to identify the invention in the context of commonly configuration networked hardware. The hardware is general purpose and is not the invention of the Applicant. The following is from the Applicant's Specification and it is the Applicant's description of Figure 1:

Referring now in more detail to the drawings, in which like numerals indicate corresponding parts throughout the several views, FIG. 1 illustrates an example system 100. As indicated in that figure, the system 100 generally comprises a network-accessible computing device 102, one or more peripheral devices 104, and a user computing device 106, each of which is connected to a network 108.

The network-accessible computing device 102 can comprise, for example, a network server, such as a web server, that hosts a firmware service that both notifies users of available peripheral device firmware and facilitates installation of such firmware. By way of example, the network-accessible computing device 102 is operated by or on behalf of the peripheral device manufacturer or firmware developer.

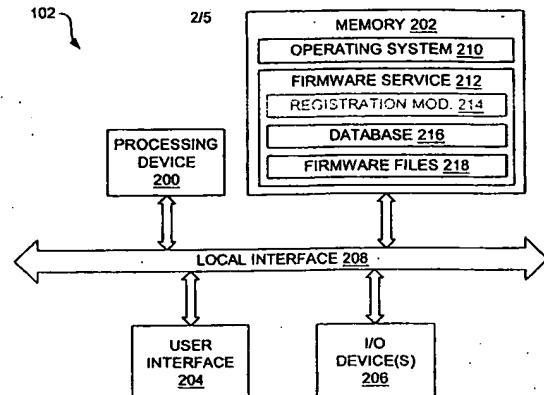
The peripheral devices 104 are devices of the type that are peripheral to a computing device, such as personal computer (PC) and/or that are available for walk-up use. By way of example, the peripheral devices 104 each comprise a printing device that is capable of generating hard copy documents from data that is transmitted to and/or collected by the device. In the example system configuration shown in FIG. 1, the peripheral devices 104 are printing devices including a printer 110, a photocopier 112, and a multi-function peripheral (MFP) device 114 which is capable of performing multiple tasks such as printing, copying, scanning, faxing, and emailing. Although particular peripheral devices 104 are shown in FIG. 1, the peripheral devices of the system 100 may comprise any device on which firmware may be installed and that is connectable to the network 108.

The user computing device 106 is a local computer that, for instance, shares a local area network (LAN) with the peripheral devices 104. In the example of FIG. 1, the user computing device 106 is a personal computer (PC). Although a PC is shown in FIG. 1 and has been identified herein, the user computing device 106 could, alternatively, comprise another type of computer including, for instance, a Macintosh™ computer, a notebook computer, or other computing device that is capable of communicating with the network-accessible computing device 102 and/or the peripheral devices 104. Optionally, the user computing device 106 may comprise a software program that is used to control and administer each of the peripheral devices 104 on a given network (e.g., LAN).

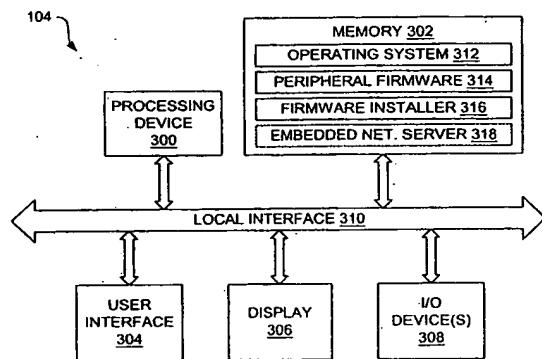
The network 108 normally comprises multiple sub-networks that are communicatively coupled to each other. By way of example, the network 108 comprises one or more wide area networks (WANs) and LANs, and further comprises part of the Internet.

#### END OF SECTION FROM SPECIFICATION

When reviewing Figures 2 and 3 the description is clear the matter depicted in Figures 2 and 3 are part of the invention and the intent is to use the general purpose hardware networked in Figure 1. But Figure 1 fails to indicate any inventive concepts by the Applicant. the following are Figures 2 and 3.



**FIG. 2**



**FIG. 3**

Applicant's Figures 2 and 3

Applicant's refusal to not the networked general purpose hardware is not proper. Several ways to over come the objections exist.

1. Label Figure 1 as Prior Art
2. Amended Figure to add label indicating the invention is present in Figure 1 and add the support in the section above using consistent wording as not to add new matter.

"Claims 8-12 and 20-34 have been rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter.

Regarding claims 8-12 and 20-24, recited in the claim are various "means." Applicant notes that nowhere in the claims or the specification is it stated that those means are limited only to "software." For example, regarding claim 8, it is possible to interpret the "means for transmitting" as including a physical transmission device, such as a modem, transceiver, router, etc. In view of that, claims 8-12 are not necessarily limited to "software" and therefore constitute statutory subject matter under 35 U.S.C. § 101."

Examiner's Response

Applicant's preamble is "A system for facilitating installation of firmware on a printing device...". Yet, Applicant states they are not limited to software. One of ordinary skill in the art should know that firmware itself is hardware. The updating is performed by downloading of code to update the firmware. The code is in the format of software. Applicant's statement that they might be something other than software is not supported in the Specification. How does Applicant point to the Specification for support of "A system for facilitating installation of firmware on a printing device", where the download is hardware. Applicant's arguments have introduced a new grounds of rejection under 35 U.S.C. 112 first paragraph (see below).

Second, Applicant argues, For example, regarding claim 8, it is possible to interpret the "means for transmitting" as including a physical transmission device, such as a modem, transceiver, router, etc. Applicant's argument that the invention can be interpreted as a "means for transmitting" has introduced an additional rejection under 35 U.S.C. 101, where the Applicant appears to be claiming a signal. Which is not statutory.

Applicant's arguments are not persuasive.

**Claim Rejections - 35 U.S.C. § 101 – Claims 25-28**

Applicant's Argument

"Regarding claims 25-28, Applicant has amended the claims to recite a 'computer readable medium'. Applicant submits that such a medium constitutes a "manufacture" under 35 U.S.C. § 101."

Examiner's Response

Claims fail to clearly and concisely claim the result being tangibly embodied on the computer readable medium applicant has added to the preamble.

**Claim Rejections - 35 U.S.C. § 101 – Claims 28 -34**

Applicant's arguments for claims 28 – 34.

"Finally, regarding claims 28-34, Applicant recites a "printing device". Clearly such a device qualifies as either a mine," a 'manufacture,' or both under 35 U.S.C. § 101.

In view of the above, Applicant respectfully submits that all claims are directed to statutory subject matter as defined by 35 U.S.C. § 101 and therefore respectfully requests that the rejection be withdrawn."

Examiner's Response

Applicant's has no support for inventing a printing device. Argument has introduced new grounds of rejection under 35 U.S.C. 112 First paragraph.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 – 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 – 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 – 34 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The development and distribution of hardware is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

***Double Patenting***

8. Claims 1 – 34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 15 of U.S. Patent No. #7,146,412 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because.

**Claim 1**

A methods for facilitating installation of firmware on a printing device, the method comprising: transmitting from a computer a notification that firmware is available for installation on a printing device; receiving with the computer a firmware download request; and transmitting a firmware file directly to the printing device to enable installation of the firmware on the printing device. (See '412 Claims 1 and 10).

**Claim 2**

The method of claim 1, wherein transmitting a notification comprises transmitting a notification directly to the printing device. (See '412 Claims 1 and 10).

**Claim 3**

The method of claim 1, wherein transmitting a notification comprises transmitting an email to the user. (See '412 Claims 1 and 10).

**Claim 4**

The method of claim 3, wherein transmitting an email message to a user comprises transmitting a link to a network page at which firmware download can be requested. (See '412 Claims 1 and 10).

**Claim 5**

The method of claim 1, wherein receiving a firmware download request comprises receiving a firmware download request transmitted is the computer from the printing device. (See '412 Claims 1 and 10).

**Claim 6**

The method of claim 1, wherein transmitting a firmware file comprises transmitting a remote update (RFU) file directly to the printing device. (See '412 Claim 2).

**Claim 7**

The method of claim 1, further comprising registering the printing device with a firmware service and determining whether to transmit a notification based upon information that was collected through registration of the printing device.

Examiner Interpretation

Registration process deemed Inherent in Installation Process – See '412, Claim 5

**Claim 8**

A system for facilitating installation of firmware on a printing device. the system comprising:  
means for transmitting a notification to a device indicating that new firmware is available for installation on the printing device;  
means for receiving a firmware download request; and  
means for transmitting a firmware file directly to the printing device.

As per claim 1.

**Claim 9**

The system of claim 8, wherein the means for transmitting a notification comprise means for transmitting a notification directly to a printing device. As per claim 2.

**Claim 10**

The system of claim 8, wherein the means for transmitting a notification comprise means for transmitting an small message to a user, the email message including a link to a network page at which firmware download can be requested. (See '412 Claims 1 and 10).

**Claim 11**

The system of claim 8, wherein the means for transmitting a firmware file comprise means for transmitting a remote firmware update (RFU) file to the printing device. As per claim 6 above.

**Claim 12**

The system of claim 8, further comprising means for registering a printing device with a firmware service.

Examiner Interpretation

Registration process deemed Inherent in Installation Process – See '412, Claim 5

**Claim 13**

A method for facilitating installation of firmware on a printing device, the method comprising: a peripheral device receiving a firmware availability notification; and the printing device providing a related notification to a user. As per claim 1.

**Claim 14**

The method of claim 13, wherein the printing device providing a related notification to a user comprises the printing device providing a notification on a network page using a network server embedded in the printing device. As per claim 1.

**Claim 15**

The method of claim 13, wherein the printing device providing a related notification to a user comprises the printing device transmitting a message to a user computing device. See '412, Claim 1

**Claim 16**

The method of claim 13, wherein the printing device providing a related notification to a user comprises the printing device displaying a notification in a display of the printing device. As per claims 1 and 3.

**Claim 17**

The method of claim 13, further comprising the printing device receiving a request to install available firmware. See '412, Claim 5

**Claim 18**

The method of claim 17, further comprising the printing device transmitting a firmware download request to a firmware service. See '412, Claim 5

**Claim 19**

The method of claim 18, further comprising the printing device receiving a firmware file and installing the firmware on the printing device. See '412, Claim 5

**Claim 20**

A system for facilitating installation of firmware on a printing device, the system comprising: means provided on a printing device for receiving a notification from a firmware service that new printing device firmware is available for download; and means provided on the printing device for providing a related notification to a device user. As per claim 1.

**Claim 21**

The system of claim 20, wherein the means for providing a related notification comprise an embedded network server of the printing device that is configured to post a notification on a network page. See '412, Claims 1 and 5

**Claim 22**

The system of claim 20, wherein the means for providing a related notification comprise means for transmitting a message from the printing device to a user computing device. As per claim 3.

**Claim 23**

The system of claim 20, wherein the means for providing a related notification comprise means for displaying a notification in a display of the printing device. As per claim 16.

**Claim 24**

The system of claim 20, further comprising means for receiving and installing a firmware file on the printing device. As per claim 19.

**Claim 25**

A computer readable medium that contains a firmware service, the service comprising: logic configured to transmit firmware availability notifications directly to the printing devices; logic configured to receive firmware download requests from the printing device; and logic configured to transmit firmware files directly to the printing devices.

See the rejection for claim 1.

**Claim 26**

The computer readable medium of claim 28, wherein the logic configured to transmit firmware files comprises logic configured to transmit remote firmware update (RFU) files directly to the printing devices. As per claim 6.

**Claim 27**

The computer-readable, medium of claim 25, further comprising logic configured to register printing devices with the firmware service. As per claim 7.

**Claim 28**

The computer-readable medium of claim 27, further comprising logic configured to determine whether to transmit firmware availability notifications based upon collected printing device registration information.

**Examiner Interpretation**

Registration process deemed Inherent in Installation Process – See '412, Claim 5

**Claim 29**

A printing devices, comprising: memo including logic configured to directly receive firmware availability notifications that are transmitted by a firmware service via a network; and logic configured to provide related notifications to a user. As per claims 1 and 3.

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**Claim 30**

The printing device of claim 29, wherein the logic configured to provide related notifications comprises an embedded network server that is configured to post notifications on network pages accessible via a network browser. See '412, Claim 5.

**Claim 31**

The printing device of claim 29, wherein the logic configured to provide related notifications comprises logic configured to transmit email messages to a user computing device that indicate that firmware is available for installation. As per claims 3 and 7.

**Claim 32**

The printing device of claim 29, further comprising a display and wherein the logic configured to provide related notifications comprises logic configured to present notifications in the display. As per claim 23.

**Claim 33**

The printing device of claim 29, further comprising logic configured to receive a firmware installation request and logic configured to transmit a firmware download request to the firmware service. As per claim 19.

**Claim 34**

The printing device of claim 33, further comprising logic configured to receive and install firmware files. As per claim 19.

*Conclusion*

9. Applicant's response introduced new issues. Examiner has elected to make this action non final. Responses to Double Patenting rejections often contain arguments with merit that require more time than after final practices enables. To be fair to the Applicant and the Examiner this action is non final.

*Correspondence Information*

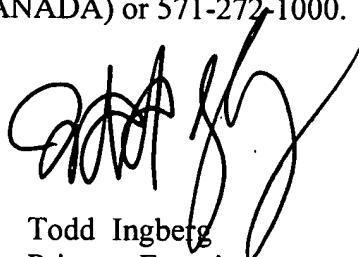
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Todd Ingberg  
Primary Examiner  
Art Unit 2193

TI